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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PAN, YUWEN

ART UNIT PAPER NUMBER

2682

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/788,493

Applicant(s)

SUONPERA ET AL.

Examiner

Yuwen Pan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/21/04</u> | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

1. Applicant's arguments with respect to claims 7-9, and 11-20 have been considered but are moot in view of the new ground(s) of rejection.
2. the applicant argues that Piosenka reference doesn't teach the limitation of wherein the transferring of the personalized information from the handheld portable phone to the computer occurs in a single session and continues until all personalized information is transferred. The examiner respectfully disagrees because the Piosenka reference does implicitly teach it (see column 6 and lines 48-52).

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 7 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 7 and 11 includes limitation "the transferring of the personalized information from the first handheld portable to the second handheld portable phone occurs in a single session and continues until all personalized information is transferred" is not described in the specification. An interpretation of this limitation is that two handheld portable phones

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simultaneously connect to a computer and communicate to each other via the computer, in which is different from what the specification indicates. The specification only teaches that a single session is occurred and continues until all information is transferred between a handheld portable phone and the computer (see figure 3). For the completion of the office action, the examiner is going to treat claim 1, 7 and 11 as according to the teaching of the specification.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, and 5, 6, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Piosenka et al (EP000827353A2).

Per claims 1, 6, 10 Piosenka et al discloses s a method and program product of transferring personalized information from one hand portable phone having a memory means for storing said personalized information to a computer on which a data transfer application is running (see column 7 and lines 39-44), comprising:

Establishing a connection between said first hand portable phone and said computer (see figure 1),

Controlling the data transfer application on the computer to read said personalized information, such as phone books, from said first memory means for storing said personalized information in said first hand portable phone to memory means associated with said data transfer application in the computer and allow user to individually select the type of personalized

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information to be corrected or updated prior to further transferring (see figure 5 - 7, column 8 and lines 36-52);

a second hand portable in which connect to the computer in order to receive the personalized information that has downloaded from the first portable phone (see column 6 and lines 55-60);

wherein the transferring of the personalized information from the handheld portable phone to the computer occurs in a single session and continues until all personalized information is transferred (see column 6 and lines 48-52).

Per claim 2, Picosenka further discloses that the personalized information includes phone numbers, message content, profile setting, and cell setting and service settings (see column 1 and lines 10-15, column 2 and lines 5-10).

Per claim 3, Picosenka further discloses that the established connection between the computer and phone is a wire-based data connection (see column 7 and lines 24-38).

Per claim 5, Piosenka further discloses that the user is allowed to individually select the type of personalized information to be read from the first memory means prior to the initializing of the data transfer (see column 8 and lines 36-53).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 7-9, 11-13, 15-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piosenka et al (EP000827353A2) in view of Dahm (US006301471B1).

Per claim 7, 16, 17 and 20, Piosenka et al discloses a method and program product of transferring personalized information from one hand portable phone having a memory means for storing said personalized information to a computer on which a data transfer application is running (see column 7 and lines 39-44), comprising:

Establishing a connection between said first hand portable phone and said computer (see figure 1),

Controlling the data transfer application on the computer to read said personalized information, such as phone books, from said first memory means for storing said personalized information in said first hand portable phone to memory means associated with said data transfer application in the computer and allow user to individually select the type of personalized information to be corrected or updated prior to further transferring (see figure 5 - 7, column 8 and lines 36-52);

a second hand portable in which connect to the computer in order to receive the personalized information that has downloaded from the first portable phone (see column 6 and lines 55-60);

wherein the transferring of the personalized information from the handheld portable phone to the computer occurs in a single session and continues until all personalized information is transferred (see column 6 and lines 48-52).

Piosenka doesn't teach that a secure WAP session connection is established.

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Dahm teach to utilize WAP for communication session of handheld device (see column 9 and lines 58-65).

It would have been obvious to one ordinary skill in the art at the time the invention was made to combine the teaching of Dahm with Piosenka's device such that the WAP, a common standard, simplifies the translation between handheld devices. Furthermore, for your information, wireless application protocol was introduced in January, 1998 by Ericsson, Motorola, Nokia and Unwired Planet. The purpose of this protocol is to create a global wireless protocol specification that works across differing wireless network technology type for adoption by appropriate industry standards bodies.

Per claims 9 and 19, Piosenka further discloses that the user is allowed to individually select the type of personalized information to be read from the first memory means prior to the initializing of the data transfer (see column 8 and lines 36-53).

Per claim 12, Piosenka further discloses that the personalized information includes phone numbers, message content, profile setting, and cell setting and service settings (see column 1 and lines 10-15, column 2 and lines 5-10).

Per claim 13, Piosenka further discloses that the established connection between the computer and phone is a wire-based data connection (see column 7 and lines 24-38).

Per claim 15, Piosenka further discloses that the user is allowed to individually select the type of personalized information to be read from the first memory means prior to the initializing of the data transfer (see column 8 and lines 36-53).

9. Claims 4, 8, 14 and 18, are rejected under 35 U.S.C. 103(a) as being unpatentable over Piosenka et al (EP000827353A2) in view of Ishigami (US006625445B1).

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Piosenka discloses an analogous system as recited in claim 1. Piosenka and doesn't teach a step of evaluating the capabilities of the phones to receive the data information.

Ishigami discloses that a system that transferring a plurality of data from a computer to a portable phone in which determine whether the portable phone is capable to receive such plurality of data (see column 2 and lines 12-22).

It would have been obvious to one ordinary skill in the art at the time the invention was made to combine the teaching of Ishigami with the combination of Piosenka and Bernd such that no plurality of data would be transferred until the receiving party is ready and avoid error and overload the receiving party.

### *Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lieu et al (US006708045B1) discloses easily reconfigured and upgraded radio card and wireless terminal.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yuwen Pan whose telephone number is 703-305-7372. The examiner can normally be reached on 8-5 M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Yuwen Pan  
October 29, 2004

  
LEE NGUYEN  
PRIMARY EXAMINER